Remarks

Claims 1 to 38 are pending. Claims 1-29 are rejected. Claims 30 to 38 have been withdrawn from consideration. Claims 1, 2, 5, 6, and 14 are hereby amended.

Rejections

§ 103 Rejections

Applicants respectfully submit that according to MPEP 2142, to establish a case of prima facie obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references or generally known to one skilled in the art, to modify or combine reference teachings, 2) there must be reasonable expectation of success, and 3) the prior art references must teach or suggest all the claim limitations. The ability to modify the method of the references is not sufficient. The reference(s) must provide a motivation or reason for making the changes. *Ex parte Chicago Rawhide Manufacturing Co., 226 USPQ 438 (PTO Bd. App. 1984).*

Claims 1-6, 9, 12-16, 18-21, 24, 25, and 28-29 stand rejected under 35 USC § 103(a) as being unpatentable over McHugh (U.S. 5,286,207) in view of Lewis (U.S. 5,492,481).

The Office Action states in part:

McHugh teaches an ejector mechanism coupled to the body and the button, the ejector mechanism being configured to eject the card from the body upon longitudinal movement of the button relative the body, through sliding pate 72 and lever 62 for card ejection/extraction. These parts are understood to comprise a mechanism to facilitate ejection, and hence are understood to form an ejection mechanism, or an arrangement of parts for ejection purposes.

. . .

McHugh fails to teach the use of a monolithic ejection mechanism. Though McHugh teaches an ejection mechanism that is made of several components, it would have been obvious at the time the invention was made, to make an integral/monolithic mechanism, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves routine skill in the art. (citing Howard v. Detroit Stove Works, 150 U.S. 164 (1893)).

Lewis teaches a monolithic ejector mechanism 206 that is coupled to the body/frame and push arm/button (Fig. 11A). The mechanism slides against the body as it is rotated on and around aperture 244 of the frame/body, and therefore is in a necessarily sliding/pressing relationship with the frame/body. Re claim 2, Lewis also teaches the ejector includes a pivot cam to slide against the body so that

movement of the button relative to the body causes the mechanism to pivot about the pivot cam to eject the card (FIG. 11A) where the pivot 246 are interpreted as the pivot cam that slides against the body. Re claims 6 and 15, Lewis teaches the body includes a curved portion to receive and slide the pivot cam, as discussed above through hole 244. Re claim 16, the pivot cam has a curved outer surface that has roughly the same radius as the outer surface as the body it engages (FIG. 11A).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of McHugh with those of Lewis.

One would have been motivated do this to create an integral ejection mechanism, as is well known and conventional in the art, and has the predicted results of reducing the number of independent parts/costs/assembly, while facilitating ejection of the card under various circumstances and orientations (left/right).

Applicants have amended the claims 1 and 14 to add the limitation that the ejector mechanism has a protrusion that slides against a wall of the body and have amended claims 2, 5, and 6 to conform to the added limitation.

Applicants respectfully submit that the references cannot support a case of *prima facie* obviousness as to the amended claims because, among other possible reasons, the cited references do not provide a motivation or suggest for a protrusion on the ejector mechanism that slides against a wall of the body because the ejector mechanisms of the references operate by different means. Furthermore, there could be no reasonable expectation of success. The Examiner asserts that it would be obvious to form the several components of the McHugh ejector mechanism into one piece. However, it is apparent from reviewing the figures of McHugh that if the components of the McHugh ejector mechanism were formed into one piece, the ejector mechanism could not move because lever portion 62 would not be able to pivot. In addition, these references do not disclose all the elements of the present invention because they do not disclose a protrusion on the ejector mechanism that slides against a wall of the body.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

Claims 7-8, 17, and 22-23 are rejected under 35 USC § 103(a) as being unpatentable over McHugh/Lewis, as applied to claim 1 above, and further in view of Broschard, III et al. (U.S. 5,389,001).

Applicants incorporate by reference their response, above, to the rejection based on McHugh in view of Lewis. Applicants further submit that the combination of McHugh, Lewis,

and Broschard cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references, in combination, do not provide a motivation or suggestion for a protrusion on the ejector mechanism that slides against a wall of the body. In addition, the addition of Broschard does not make up for the deficiencies of McHugh and Lewis as a basis for an obviousness rejection.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

Claims 10-11, 26, and 27 are rejected under 35 USC § 103(a) as being unpatentable over McHugh/Lewis, as applied to claim 1 above, and further in view of Okubo et al. (U.S. 5,151,989).

Applicants incorporate by reference their response, above, to the rejection based on McHugh in view of Lewis. Applicants further submit that the combination of McHugh, Lewis, and Okubo cannot support a case of *prima facie* obviousness as to the claims because, among other possible reasons, the cited references, in combination, do not provide a motivation or suggestion for a protrusion on the ejector mechanism that slides against a wall of the body. In addition, the addition of Okubo does not make up for the deficiencies of McHugh and Lewis as a basis for an obviousness rejection.

For these reasons, Applicant(s) submit that the cited references will not support a 103(a) rejection of the claims invention and request that the rejection be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim should be considered allowable when its parent claim is allowed. *In re McCairn*, 1012 USPQ 411 (CCPA 1954). Accordingly, provided the independent claims are allowed, all claims depending therefrom should also be allowed.

Based on the foregoing, it is submitted that the application is in condition for allowance. Withdrawal of the rejections under 35 U.S.C. 103 is requested. Examination and reconsideration of the claims are requested. Allowance of the claims at an early date is solicited.

The Examiner is invited to contact Applicant(s)' attorney if the Examiner believes any remaining questions or issued could be resolved.

Interview Summary

Applicant(s) and their attorney thank the Examiner for the telephone interview granted on June 26, 2004 during which Applicants' attorney, Melanie Gover, and Examiner Walsh discussed the differences between the apparatus of the present invention and those described in McHugh and Lewis.

Respectfully submitted,

July 14, 2004
Date

By: Melanie Gover
Melanie G. Gover, Reg. No.: 41,793
Telephone No.: (512) 984-4308

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833